REMARKS

Status of Claims

Claims 1, 3-8, 10-13, 15-20, 22-27, 29-34, 36-39, 41-46, 48-51 are currently pending.

Claims 1, 3-8, 10-13, 15-20, 22-27, 29-34, 36-39, 41-46, 48-51 stand rejected.

Claims 1, 8, 12, 19, 27, 34, 38-39, 41-45, 50 are amended herein. No new matter has been introduced.

Claim Rejections

Claims 1, 3-8, 10-13, 15-20, 22-27, 29-34, 36-39, 41-46, 48-51 have been rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over U.S. Patent No. 5,163,010 to Klein et al. (hereafter "Klein") in further view of U.S. Patent No. 4,767,917 (hereafter "Ushikubo") and in further view of U.S. Patent No. 7,099,740 to Bartholomew et al. (hereafter "Bartholomew"). Applicant respectfully traverses these rejections.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the references or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not be based on the applicant's disclosure. In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991); MPEP 2143. Here, the Examiner has failed to establish a *prima facie* case of obviousness because the combination of Klein, Ushikubo, and Bartholomew does not teach or suggest all the claim limitations of independent claims 1, 8, 12, 19, 27, 34, 38, and 45.

As further explained in applicant's September 11, 2008 response, only the present invention teaches or suggest on demand remote inventory management of a hair care or cosmetic vending apparatus and scheduling delivery to vending apparatus based on the remote inventory management, thereby eliminating the responsibility and cost associated with maintaining and managing inventory of hair care/cosmetic products.

As admitted by the Examiner, neither Klein nor Ushikubo teaches or suggests the on demand remote management of the vending device. *See, e.g.* 12/03/2008 Office Action at 3, ¶ 10. To cure this deficiency, the Examiner turns to a new reference, Bartholomew. Bartholomew, however, also does not teach or suggest a method or vending apparatus that provides for on-demand remote inventory management as required by the claims of the present invention.

Bartholomew is merely directed to a nail polish dispenser that allows for nail polish formulations to be created according to a customer's specifications at the point-of-sale ("POS"). *See, e.g.*, Bartholomew, col. 3, 32-39. Bartholomew does not teach or suggest on demand remote inventory management of a specific vending device and scheduling delivery to the vending device based on the remote inventory management, as required in claims of the present invention. In fact, column 6, lines 44-67 to column 7, lines 1-2 in Bartholomew, cited by the Examiner, does not disclose compiling data for the purpose of managing the inventory of each specific vending device when an actual purchase is made and also scheduling a delivery of the required product, as required in claims of the present application. To the contrary, Bartholomew merely describes compiling data "for evaluating demographic correlations, as to consumer color preference data . . ." for purposes of studying overall demographic preferences. It is appreciated that one of ordinary skill in the art would not confuse Bartholomew's demographic preference study with the present invention's on demand remote inventory management of the vending device and scheduling delivery of products to the vending device based on the remote inventory management.

"To imbue one of ordinary skill in the art with knowledge of the present invention, when no prior art reference or references of record convey or suggest that knowledge, is to fall victim of the insidious effect of hindsight syndrome, wherein that which only the inventor taught is used against the teacher." W.L. Gore & Assoc. v. Garlock, Inc., 721 F.2d 1540, 1553 (Fed. Cir. 1983). The prior must to be judged based on a full and fair consideration of what that art teaches, not by using applicant's invention as a blueprint for gathering various bits and modifying the pieces in an attempt to reconstruct applicant's invention. The Examiner cannot simply change the principle of the operation of the reference or render the reference inoperable for its intended purpose to render the claims unpatentable. Nowhere does Bartholomew teach or

suggest on demand remote inventory management of the vending device and scheduling delivery of the products to the vending device based on the remote inventory management, as required in the claims of the present application. Accordingly, it is submitted that the Examiner has succumbed to the lure of prohibited hindsight reconstruction.

Moreover, the present invention solves a problem that was simply not at issue in any of the cited references, namely how to remotely manage the product inventory of the vending devices in many locations and schedule delivery so the vending devices are properly stocked with the products. It is undeniable that none of the cited references individually or in combination therewith are remotely concerned with the problem of on demand remote inventory management of the vending device and scheduling delivery of the products to the vending device based on the remote inventory management. Since applicant has recognized a problem not addressed by the cited prior art and solved that problem in a manner not suggested by the cited prior art, the basis for patentability of the claims is established. See *In re Wright*, 6 U.S.P.Q. 2d, 1959, 1961-1962 (Fed. Cir. 1988). There, the CAFC relied upon previous decisions requiring a consideration of the problem facing the inventor in reversing the Examiner's rejection. "The problem solved by the invention is always relevant". *Id.* at 1962. See also, *In re Rinehart*, 189 U.S.P.Q. 143, 149 (CCPA 1967), which stated that the particular problem facing the inventor must be considered in determining obviousness.

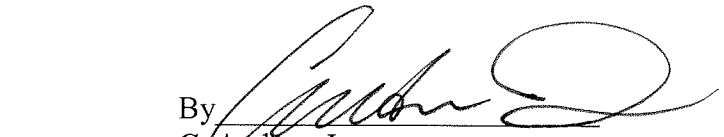
Further, applicant incorporates by reference all the arguments made in its September 11, 2008 response, with respect Klein and Ushikubo. The Examiner cannot simply change the principle of the operation of the references or render the references inoperable for their intended purposes to render the claims unpatentable. Even if one of ordinary skill in the art combines Klein and Ushikubo with Bartholomew, as suggested by the Examiner, there is no reasonable expectation of success because the resulting combination will not result in the present invention. None of the cited references teach or suggest on demand remote inventory management of the vending device and scheduling delivery of products to the vending device based on the remote inventory management Therefore, the Examiner has again failed to establish a *prima facie* case of obviousness because there is no reasonable expectation of success in combining Klein and Ushikubo with Bartholomew because the resulting combination will not result in the present invention.

In view of the above, applicant believes that the pending application is in condition for allowance and requests that the Examiner's rejections be reconsidered and withdrawn.

Applicant believes no fee is due with this response. However, if a fee is due, please charge our Deposit Account No. 50-0624, under Order No. **NY-WELLA-204-US** (10207602) from which the undersigned is authorized to draw.

Dated: February 10, 2009

Respectfully submitted,



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